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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,927	03/16/2001	Eugene Medlock	01017/36917A	7150

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EXAMINER

ANDRES, JANET L

ART UNIT PAPER NUMBER

1646

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/810,927	MEDLOCK ET AL.	
	Examiner	Art Unit	
	Janet L. Andres	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-12, 14, 59-61, 74, 75, 91, 92 and 97-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 100 is/are allowed.
- 6) ☒ Claim(s) 4-12, 14, 59-61, 74, 75, 91, 92, 97-99 and 102-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/4/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 April 2004 has been entered. Claims 4-12, 14, 59-61, 74, 75, 91, 92, and 97-104 are pending and under examination in this office action. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

Claim Rejections/Objections Withdrawn

The objection to claim 12 as being multiply dependent is withdrawn in response to Applicant's cancellation of this claim.

The rejection of claims 1-3, 14, and 59-61 under 35 U.S.C. 101 as claiming the same invention as 09/723232 and the rejection of claims 5-12 and 90-96 under the judicially created doctrine of obviousness-type double patenting is withdrawn in response to the abandonment of 09/723232.

Claim Rejections Maintained/New Grounds of Rejection

Claim Rejections - 35 USC § 102

Claims 4-6, 10-12, 14, 59-61, 91, 92, 97-99, and 101-104 are rejected under 35 U.S.C. 102(a) as anticipated by WO 99/14240 for reasons of record in the office actions of 17 December 2002 and 28 July 2003.

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Applicant argues that the claims no longer recite hybridization conditions. However, the polypeptide sequence in figure 1A of WO 99/14240 comprises amino acids 1-421 of Applicant's SEQ ID NO: 2 and thus the polynucleotide encoding it encodes a sequence comprising 1-292 of SEQ ID NO: 2, a sequence comprising 14-292 of SEQ ID NO: 2, a sequence comprising a fragment of these regions, and a sequence of 90% identity to these regions. Since SEQ ID NO: 7 is a truncation of SEQ ID NO: 2 with an initiating methionine, the sequence also encodes a polypeptide comprising a fragment of this sequence and a sequence comprising a sequence at least 90% identical to amino acids 1-175 of SEQ ID NO: 7.

Claims 4-6, 10-12, 14, 59-61, 91, 92, 97-99, and 101-104 are also rejected under 35 U.S.C. 102(e) as anticipated by US 2002/0102639 for reasons of record in the office actions of 17 December 2002 and 28 July 2003.

US 2002/0102639 teaches the amino acid sequence of EVI27, which differs from instant SEQ ID NO: 2 only in the isoleucine at position 6. The polynucleotide sequence reported by US 2002/0102639 diverges from instant SEQ ID NO: 1 because of alternative splicing; however, polynucleotides encoding this sequence are taught in paragraph 54. Thus US 2002/0102639 teaches polynucleotides encoding a sequence comprising amino acids 14-292 of SEQ ID NO: 2, a sequence comprising a fragment of this region, and a sequence of 90% identity to these regions. Since SEQ ID NO: 7 is a truncation of SEQ ID NO: 2 with an initiating methionine, the sequence also encodes a polypeptide comprising a fragment of this sequence and a sequence comprising a sequence at least 90% identical to amino acids 1-175 of SEQ ID NO: 7.

Claims 4-6, 10-12, 14, 59-61, 74, 75, 91, 92, 97-99, and 101-104 are newly rejected under 35 U.S.C. 102(e) as anticipated by WO 01/46420 (Chen et al., priority December 1999).

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WO 01/46420 teaches a sequence that appears to be identical to SEQ ID NO: 2 in figure 12. A polynucleotide encoding it is presented in figure 11. Thus WO 01/46420 teaches a polynucleotide encoding SEQ ID NO: 2. Since SEQ ID NO: 7 is a truncation of SEQ ID NO: 2 with an initiating methionine, the sequence also encodes a polypeptide comprising a fragment of this sequence and a sequence comprising a sequence at least 90% identical to amino acids 1-175 of SEQ ID NO: 7.

Claim Rejections - 35 USC § 112

Claims 102-104 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants' referral to the deposit of on page 8 of the specification and in claims 2 and 4 is an insufficient assurance that all of the conditions of 37 CFR sections 1.801 through 1.809 have been met. If the deposits were made under the provisions of the Budapest Treaty, filing of an affidavit or declaration by applicants, assignees or a statement by an attorney of record over his or her signature and registration number stating that the deposits have been accepted by an International Depository Authority under the provisions of the Budapest Treaty, that all restrictions upon public access to the deposits will be irrevocably removed upon the grant of a patent on this application and that the deposit will be replaced if viable samples cannot be dispensed by the depository is required. This requirement is necessary when deposits are made under the provisions of the Budapest Treaty as the Treaty leaves these specific matters to the discretion of each State.

Claim Rejections - 35 USC § 101

Claims 5-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Because they do not require that the host cells be isolated, they encompass cloned humans.


CLAIMS 4-12, 14, 59-61, 74, 75, 91, 92, 97-99, AND 101-104 ARE REJECTED. CLAIM 100 IS ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Andres whose telephone number is 571-272-0867. The examiner can normally be reached on Monday-Thursday and every other Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Andres, Ph.D.
Primary Examiner
July 25, 2004


JANET ANDRES
PATENT EXAMINER